

MAY 13 2004

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TO THE UNITED STATES PATENT OFFICE

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Applicants Docket Number:
USST98032 US PCTApplicants:
BRANELLEC, et al.Serial No.
09/787,995Filing Date:
July 9, 2001Title of Invention:
USE OF SPECIFIC HYBRID PROMOTERS FOR CONTROLLING TISSUE EXPRESSION

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Maria Marvich, Ph.D. at 703-872-9306, on Date of Deposit May 13, 2004
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Signature _____

Total Number of Pages Sent: 3

Attorney: F. Aaron Dubberley
Reg. No. 41,001
Group Art Unit: 1636
Examiner: MARVICH, MariaTO: Mail Stop Patent Application
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

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In re Application of
BRANELLEC, et al.

Examiner: MARVICH, Maria

MAY 13 2004

Art Unit: 1636

Application No.: 09/787,995

Filed: July 9, 2001

Title: **USE OF SPECIFIC HYBRID
PROMOTERS FOR CONTROLLING
TISSUE EXPRESSION**

TELEFAX CERTIFICATE

I hereby certify that this correspondence is being
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Signature: *John Hall, Sr.*

REPLY TO OFFICE ACTION

Mail Stop PCT
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action dated February 13, 2004 for the above-identified application, Applicants respectfully request withdrawal of the finality of the Office Action and traverse all rejections of the claims. The Commissioner is authorized to charge any additional fees or credit any overpayment necessitated by this response to Deposit Account No. 18-1982.

Applicants respectfully request that the finality of the February 13, 2004 Office Action be withdrawn and a new Office Action be issued. Applicants have had no opportunity to evaluate or rebut the rejections contained in the Office Action, because those rejections rely on newly cited art that was not properly identified in, or transmitted with, the final Office Action.


The February 13, 2004 Office Action has attached to it two diagrams, one of which appears to be a plasmid map labeled "PASN286-56" and one of which appears to be a plasmid map labeled "pASN286-56GB". The only dates on these two attachments are dates in 2004 and appear to be facsimile transmission dates. The Office Action contains no data on the origin, date of publication or prior art status of either of these diagrams. Accordingly, Applicants cannot determine whether these

diagrams are, in fact, prior art. Furthermore, the copies of the diagrams presented with the Office Action are poor and contain illegible text and symbols. Despite these failings, the Office Action clearly relies on these diagrams to support its arguments. See, for example, the paragraph bridging pages 5 and 6 of the Office Action, which reads, in part:

"Therefore the enhancer and promoter are less than 1 kb apart. This is conveyed in the plasmid map which is attached to this office action and confirms that the hybrid promoter is as described, with no intervening sequences between the enhancer and promoter. Therefore the plasmid of Antelman et al. meets the limitations of the instant invention."

It is impossible for Applicants to reply meaningfully to the arguments contained in the Office Action because they are unable to evaluate the origin, publication date, or prior art status of the plasmid maps attached to the Office Action. Applicants aren't even able to read certain parts of the plasmid maps. Most importantly, Applicants have been offered no opportunity to evaluate the Office Action's essential implication, that these plasmid maps somehow display what one of skill in the art would have been able to determine about the plasmids disclosed in the Antelman et al reference at the time the instant application was filed. Accordingly, Applicants respectfully request that the finality of the February 13, 2004 Office Action be withdrawn and a new Office Action issued containing full information that will allow applicants to properly evaluate the art relied on in rejecting the instant claims.

Respectfully submitted,


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